

### **REMARKS**

The following remarks are made in response to the Office Action mailed October 13, 2005 and the official communication mailed May 2, 2006. Claims 1-20 are pending in the application. New claim 20 has been added and depends from claim 1. Claim 6 has been amended to depend from claim 5. Applicant respectfully requests reconsideration of the application in view of the following remarks.

In the Office Action, claim 6 was rejected under 35 U.S.C. §112, ¶2. Specifically the Office Action states that the element “the securing system” lacks antecedent basis. As amended herein, claim 6 depends from claim 5. In claim 5, the element of a “securing system” is positively introduced. The securing system referred to in claim 6 refers to that introduced in claim 5. It is submitted that claim 6 complies with §112, ¶2 and withdrawal of the rejection is respectfully requested.

In the Office Action, claims 1-19 were rejected under 35 U.S.C. §102(b) as being anticipated by Grim (U.S. Pat. No. 5,617,650). The Office Action states that the Grim reference essentially discloses all limitations of the claim. Withdrawal of this rejection is respectfully requested.

Independent claims 1, 13, and 19 recite an arrangement for a shoe which is not shown in the Grim reference. Specifically, the claims require a shoe with a midsole having a midsole top surface and midsole bottom surface, and an outsole forefoot portion adjacent the midsole bottom surface and an outsole heel portion adjacent the midsole bottom surface. The claims further require that the stiffening member forefoot engageable portion be secured to the outsole forefoot portion and the stiffening member heel engageable portion be secured to the outsole heel portion.

The Grim reference shows an entirely different construction where the outsole is separated from the structure alleged to be a midsole by a conformable bladder such that the outsole is spaced apart from (and thus not adjacent) the structure alleged to be a midsole. Specifically, the Grim specification states that the bladder 82 is within the sole of the shoe (6:13-14) and that the bladder 82 is covered by a layer 92 of resilient material, corresponding to layer 38 in figure 3 (6:23-25). Referring to figure 3, a cutaway portion of the heel of the Grim shoe is shown. The outsole 74 is spaced apart from the layer 38 (allegedly corresponding to a midsole) by the bladder 32 (corresponding to the structure indicated by reference character 82 in figure 8). The Grim reference shows a bladder that extends the entire length of the shoe. In other words, the layer alleged to be a midsole is separated and spaced apart from (and not adjacent) the outsole by the bladder along the entire length of the shank of the shoe. Because the Grim reference does not show a shoe with a midsole having a midsole bottom surface that is adjacent a stiffening member forefoot engageable portion or a stiffening member heel engageable portion, the Grim reference fails to anticipate or render obvious the subject matter of claim 1.

Independent claim 13 is directed to similar subject matter and requires the stiffening member forefoot engageable portion be secured to the midsole bottom surface and the stiffening member heel engageable portion be secured to the midsole bottom surface. Claim 13 also requires that the midsole bottom surface be adjacent the outsole forefoot portion and the midsole bottom surface be adjacent the outsole heel portion. For the same reasons stated above, the Grim reference fails to show or teach this arrangement.

Independent claim 19 also requires that the shoe have a midsole bottom surface which is adjacent the outsole forefoot portion and the outsole heel portion. Claim 19, like claim 1, requires that the stiffening member forefoot engageable portion be secured to the outsole

forefoot portion and the stiffening member heel engageable portion be secured to the outsole heel portion. For the same reasons stated above with respect to claim 1, claim 19 is also patentable.

As claims 2-12 and 20 depend from claim 1, and claims 14-18 depend from claim 13, it is submitted that these dependent claims are also patentable over the Grim reference for the same reasons stated above as to independent claims 1 and 13.

Claim 20 is patentable for other reasons. Claim 20 further defines the invention in that the midsole bottom surface contacts the outsole forefoot portion and the outsole heel portion. Because this arrangement is not shown or taught by the Grim reference, it is patentable over the Grim reference.

Claims 2-5 are patentable for other reasons. Dependent claims 2-5 require a securing system that is adapted to interact with the closure system. The Grim reference fails to show or provide any teaching related to this subject matter. The Office Action relies upon the bladder as indicated by reference character 82 shown in figure 8 as having holes in sections 88 and 89 as corresponding to the structure that allows the securing system to interact with the closure system. However, the Grim reference does not indicate the function of the holes shown in sections 88 and 89 and upon close inspection of the reference and the remainder of the drawing figures of the Grim reference, it is submitted that conduits are passed through the referenced holes to supply the bladder with air. Specifically, the holes in sections 88 and 89 are used to supply a bladder in the tongue of the shoe with air pressure. *See* Figs. 10 and 11; 6:50-58. In the alternative, the holes shown in sections 88 and 89 of figure 8 may be used as locations for a relief valve such as the feature indicated by reference character 188 in figure 13. *See* Fig. 13; 7:9-14. Because the Grim reference fails to show a securing system that is adapted to interact with the closure system, it is submitted that the subject matter of claims 2-5 is patentable over the Grim reference.

In view of the foregoing, withdrawal of the anticipation rejection as to claims 1-19 based on the Grim reference is respectfully requested.

In the Office Action, claims 1-19 were rejected as unpatentable under Section 103(a) in view of the Sand reference (U.S. Pat. No. 5,894,684). Specifically, the Office Action states that the Sand reference discloses all of the limitations as substantially recited in the claim and that it would have been well within the skill of one of ordinary skill in the art to use the teachings of the embodiment of figure 7 in the embodiment of figures 18 and 19 to aid in better supporting the entire sole of the user's foot and shoe. Withdrawal of this rejection is respectfully requested.

For the same reasons stated above as to the Grim reference, the Sand reference also fails to show a midsole bottom surface which is adjacent an outsole forefoot portion and an outsole heel portion, a stiffening member forefoot engageable portion that is secured to the outsole forefoot portion, and a stiffening member heel engageable portion that is secured to the outsole heel portion. In the Sand reference figure 18, the shank portion 12 extends the entire length of the boot and the insert 62 extends from the heel a partial to full length of the boot. Because the insert 62 of figure 18 does not secure to the forefoot portion of the shank, the arrangement shown in figure 18 does not show or teach securing the stiffening member forefoot engageable portion to the outsole forefoot portion as required by claims 1 and 19, or a midsole bottom portion as required by claim 13. To the extent the Sand reference teaches providing an insert 62 that extends the full length of the boot, the boot of the Sand reference could not satisfy the claimed limitation of the midsole bottom surface being adjacent the outsole forefoot portion. Moreover, the tensioning system in the boot design of the Sand reference is to induce a desired forward lean in the high back portion of the boot. It has nothing to do with providing increased support in the

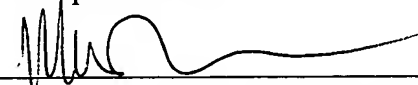
shank of the boot. For these reasons, it is submitted that claims 1-20 are patentable over the Sand reference and withdrawal of the rejection is respectfully requested.

### **CONCLUSION**

In view of the foregoing amendments and remarks, it is submitted that the application is in a condition for allowance and notification to that effect is earnestly solicited at the Examiner's earliest convenience. The Examiner is invited to contact the undersigned by telephone if any other matters require resolution prior to notification of allowance.

Respectfully submitted,  
Thompson Coburn LLP

By:

  
Matthew J. Himich, Reg. No. 47,650  
One US Bank Plaza  
St. Louis, Missouri 63101  
(314) 552-6000  
(314) 552-7000 (fax)